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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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NEW YORK, NY 10016-2711

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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/610,118

Applicant(s)

BUSFIELD ET AL.

Examiner

"Neon" Phuong Huynh

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 25 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 59-131 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims 59-131 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 1644

### DETAILED ACTION

1. **Please note** the location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1644, Group 1640, Technology Center 1600.
2. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). This application is complied with Sequence rules.
3. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.
4. Applicant's Preliminary Amendment, filed on 1/25/01 is acknowledged.  
Specification has been amended.  
Claims 1-58 have been canceled.  
Claims 59-131 have been added.  
Claims 59-131 are pending in instant application.
5. The following is noted:  
  
Claims 59-85 and claims 123-131 encompass 9 distinct antibodies, including human and mouse monoclonal antibodies that utilize different nucleic acid sequences. The claims as filed are unclear as to which hybridoma reads on which sequences. Therefore, the restriction has been set forth for each as separate groups, irrespective of the format of the claims.

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*Election/Restrictions*

6. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 59-131, drawn to single chain Fv antibody produced by hybridoma PTA 2442, classified in Class 530, subclass 387.1.
  - II. Claims 59-131, drawn to single chain Fv antibody produced by hybridoma PTA 2443, classified in Class 530, subclass 387.1.
  - III. Claims 59-131, drawn to single chain Fv antibody produced by hybridoma PTA 2444, classified in Class 530, subclass 387.1.
  - IV. Claims 59-131, drawn to single chain Fv antibody produced by hybridoma PTA 2445, classified in Class 530, subclass 387.1.
  - V. Claims 59-131, drawn to a mouse monoclonal antibody produced by hybridoma PTA-1746, classified in Class 530, subclass 387.1.
  - VI. Claims 59-131, drawn to a mouse monoclonal antibody produced by hybridoma PTA-1747, classified in Class 530, subclass 387.1.
  - VII. Claims 59-131, drawn to a mouse monoclonal antibody produced by hybridoma PTA-1748, classified in Class 530, subclass 387.1.
  - VIII. Claims 59-131, drawn to a mouse monoclonal antibody produced by hybridoma PTA-1749, classified in Class 530, subclass 387.1.
  - IX. Claims 59-131, drawn to a mouse monoclonal antibody produced by hybridoma PTA-1750, classified in Class 530, subclass 387.1.
7. The inventions are distinct, each from the other because of the following reasons:
- Groups I-IX encompass different and distinct products. In the instant case, every antibody is produced by different hybridoma that recognizes distinct epitopes of either human or mouse TANGO polypeptide. Therefore, they are patently distinct.
8. Because these inventions are distinct for the reasons given above and the search are not co-extensive and divergent subject matter, restriction for examination purposes as indicated is proper.

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9. Irrespective of whichever group applicant may elect, Applicant is further required under 35 U.S.C. 121 to select a specific **SEQ ID NO** as recited in claims 59-85 and claims 123-131, for example.

These species are distinct because the specific antibodies differ with respect to their binding specificity, produced by different hybridomas and encoded by different amino acid sequences. Therefore, they are patentably distinct.

10. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 59, 60, 61, 62, 63, 64, 122, 123, 124, 125, 126, 127, 128, and 129 are generic.
11. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

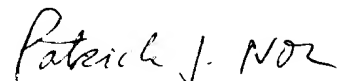
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

12. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Phuong Huynh "NEON"** whose telephone number is (703) 308-4844. The examiner can normally be reached Monday through Friday from 8:00 am to 5:00 p.m. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.
15. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Phuong N. Huynh, Ph.D.  
Patent Examiner  
Technology Center 1600  
March 21, 2001

  
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